

Application No.: 10/552,532
Amendment Dated: October 20, 2010
Reply to Office Action of: July 23, 2010

MAT-8748US

Remarks/Arguments:

Claim Status

Claims 1-13 are presently pending. Claim 1 has been amended to correct a typographical error. Support for the amendment to claim 1 may be found, for example, in the originally filed specification at Page 5, Line 3 to Page 6, Line 2. Claims 10-13 are newly added. Support for the features of claims 10-13 may be found throughout the originally-filed detailed description, drawings and claims. No new matter is added.

Claim Rejections Under 35 U.S.C. § 112

Claims 1-9 stand rejected under 35 U.S.C. 112 as failing to comply with the written description requirement. Applicant has amended the language of claim 1 to rectify the error noted by the Examiner. Support for the amendment to claim 1 may be found, for example, in the originally filed specification at Page 5, Line 3 to Page 6, Line 2.

Claim Rejections Under 35 U.S.C. § 103

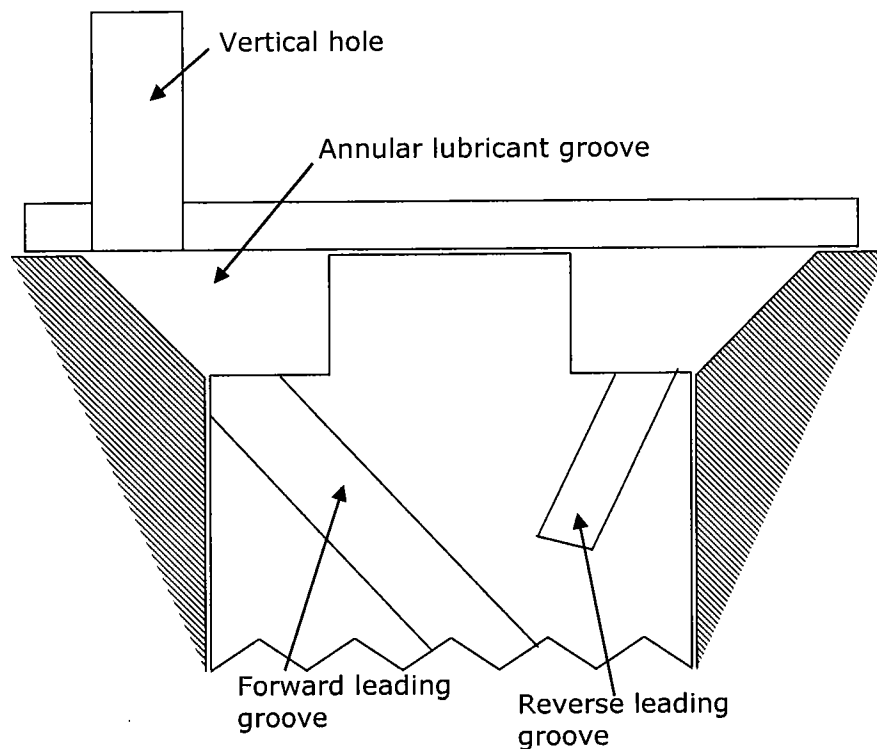
Claims 1-9 stand rejected under 35 U.S.C. 103(a) as unpatentable over Nobuo et al. (JP S62-44108) in view of Goodnight (US Pat. 6457561) further in view of Choi (US Pat. 5971724) and Stocklein (US Pat. 2996240).” Applicant respectfully requests reconsideration of the rejection of these claims for the reasons set forth below.

Applicant’s invention, as recited by claim 1, includes features which are neither disclosed nor suggested by the cited art, namely, “wherein the forward leading groove, the annular lubricant groove, and the vertical hole define a lubricant pathway such that (1) the lubricant passes from the forward leading groove to the annular lubricant groove, and (2) the lubricant passes from the annular lubricant groove to the vertical hole without re-entering the reverse leading groove.”

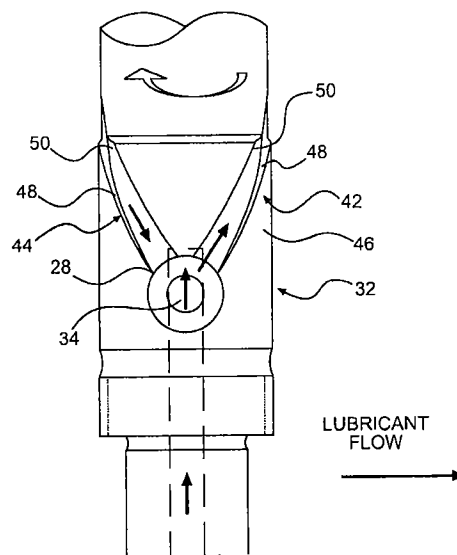
The forward leading groove opens to the inner rim of the annular lubricant groove. The vertical hole opens to the outer rim of the annular lubricant groove. Together, they form a lubricant pathway such that (1) the lubricant passes from the

forward leading groove to the annular lubricant groove, and (2) the lubricant passes from the annular lubricant groove to the vertical hole without re-entering the reverse leading groove. This feature is described in the application, for example, at page 4, line 16 to page 6, line 2; and FIGS. 1-3. No new matter is added.

The foregoing features of claim 1 are shown in the exemplary figure below for the purposes of illustration. As shown in the figure below, the forward leading groove opens to the inner rim of the annular lubricant groove. The vertical hole opens to the outer rim of the annular lubricant groove. Lubricant passes up the forward leading groove and into the annular lubricant groove. Lubricant in the annular lubricant groove passes outward (due to centrifugal force) and up into the vertical hole without entering or re-entering the reverse leading groove. Applicant respectfully submits that the cited art fails to disclose, teach, or suggest at least the foregoing features of claim 1.



The Office Action cites to Goodnight as teaching a helical groove (i.e., item 44) that is analogous to Applicant's claimed 'reverse leading groove'. Claim 1 recites "wherein the forward leading groove, the annular lubricant groove, and the vertical hole define a lubricant pathway such that (1) the lubricant passes from the forward leading groove to the annular lubricant groove, and (2) the lubricant passes from the annular lubricant groove to the vertical hole without re-entering the reverse leading groove." Emphasis Added. Contrary to the language of claim 1, however, Goodnight's compressor is configured such that lubricant travels from the groove 42 (characterized as a forward leading groove) and enters the groove 44 (i.e., the reverse leading groove). Please see the arrows in Figure 14 of Goodnight and column 9, lines 10-26 describing the distribution of lubricant back into groove 44. Applicant respectfully submits that modifying Nobou, Choi and/or Goodnight's compressor to prevent the redistribution of lubricant back through a reverse leading groove (i.e., groove 44 of Goodnight) to meet the elements of claim 1 would change the principle of operation and/or require substantial reconstruction and redesign.¹



¹ MPEP 2143.01: "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate."

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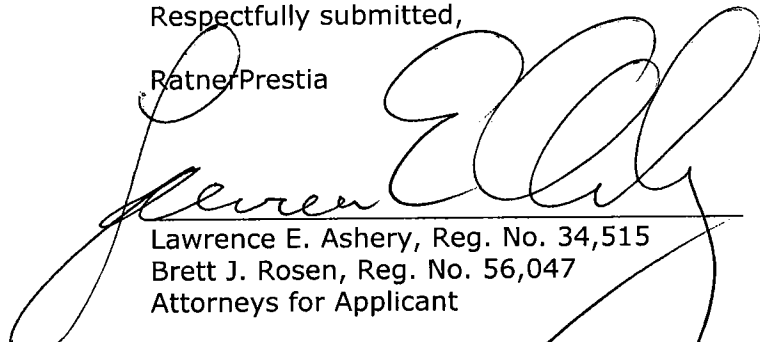
Accordingly, because claim 1 includes features that are neither disclosed nor suggested by the cited references and the proposed modification would require substantial reconstruction and redesign of the elements of the cited references, *prima facie* obviousness cannot be established based on the cited references. The dependent claims that stand rejected should also be allowed at least as being dependent upon an allowable base claim. Reconsideration of claims 1-9 is respectfully requested.

Conclusion

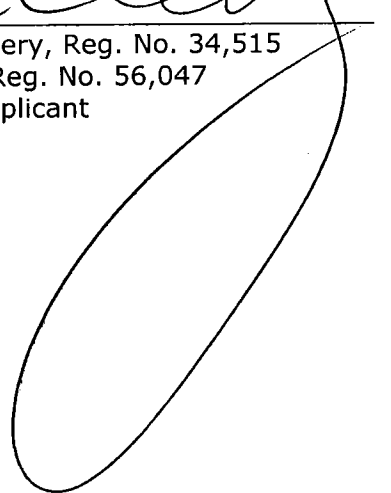
Applicant respectfully asserts that the above-identified application is in condition for allowance, which action is respectfully requested.

Respectfully submitted,

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Dated: October 20, 2010

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